

U.S. Application No. 09/658,778

Docket No. 4450-0249P

February 23, 2004

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REMARKS

Favorable reconsideration and allowance of the present application are respectfully requested in view of the following remarks. Claims 1-17 remain pending. Claims 1 and 8 are independent.

OBJECTION TO THE SPECIFICATION

The specification is objected to under 35 U.S.C. §132 as allegedly introducing new matter. More specifically, it is alleged that the added material "and another is the Synchronous Digital Hierarchy (SDH) standard used in Europe that has many similarities and is generally equivalent to SONET" is new matter.

Applicant respectfully disagrees. The proper standard to be applied to determine the new matter issue is the one of ordinary skills standard. The added material merely makes explicit what was generally known at the time the present invention was made - that SDH and SONET are generally equivalent. Indeed, even the cited reference Chen et al. (USPN 6,501,758, hereinafter "Chen") relied upon to reject the claims indicates SONET and SDH are generally equivalent. Clearly, one of

ordinary skills would realize that the two are generally equivalent.

Applicant respectfully requests that the objection to the specification be withdrawn.

§ 112, 1<sup>st</sup> PARAGRAPH REJECTION

Claims 1-17 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. More specifically, it is alleged that change from "SONET" to "SONET/SDH" is grounds for new matter. As noted above, it was generally known at the time the present invention was made that the two standards are generally equivalent. Therefore, no new matter has been introduced.

Applicant respectfully requests that the Section 112, 1<sup>st</sup> paragraph rejection be withdrawn.

§ 102 REJECTION - CHEN

Claims 1-14 stand rejected under 35 U.S.C. § 102(E) as allegedly being anticipated by Chen. Applicant respectfully traverses.

In the Rule 111 Reply filed on July 24, 2003, Applicant demonstrated that Chen may not be relied upon to teach or suggest at least the feature of "subdividing a portion of the data frames comprising a SONET/SDH layer into two or more logical channels" as recited in independent claims 1 and 8. Applicant maintains argument presented in the July 24<sup>th</sup> Reply.

Also, it should be noted that Chen's teachings are directed to **completely different layer** than the SONET/SDH layer. The Examiner has clearly recognized that Chen is directed to devices and methods of transporting asynchronous transfer mode (ATM) and/or time division multiplexed (TDM) data traffic over a fiber network. As seen in Figure 2 of the present application, **ATM and TDM traffic is part of layer 2 whereas the SONET is part of layer 1**. Chen is exclusively devoted to manipulating data at the layer 2 level.

Simply put, Chen's disclosure cannot be used to teach or suggest any data manipulation other than at the layer 2 level. The suggestion is merely that after the data is manipulated and transformed at the layer 2 level, Chen depends on the underlying layer 1 protocols to actually transport the data to the various nodes of the fiber network. Indeed, Chen is **completely silent**

regarding details of any data manipulation at the SONET/SDH level.

For at least the above reasons, independent claims 1 and 8 are not anticipated by Chen. Claims 2-7 and 9-14 depend directly or indirectly from independent claims 1 and 8. Therefore, for at least the reasons stated above with respect to independent claims 1 and 8, these dependent claims are also not anticipated by Chen.

Applicant respectfully requests that the rejection of claims 1-14 based on Chen be withdrawn.

§ 103 REJECTION - CHEN, BISSON

Claim 15 stands rejected under 35 U.S.C. §103(a) over Chen in view of Bisson et al. (U.S. Patent No. 6,349,092). Applicant respectfully traverses.

For a Section 103 rejection to be proper, a *prima facie* case of obviousness must be established. See *M.P.E.P.* 2142. One requirement to establish *prima facie* case of obviousness is that the prior art references, when combined, must teach or suggest all claim limitations. See *M.P.E.P.* 2142; *M.P.E.P.* 706.02(j). Thus, if the cited references fail to teach or suggest one or more elements, then the rejection is improper and must be withdrawn.

Claim 15 depends from independent claim 8. Claim 8 recites, in part, "a first circuit configured to subdivide a portion of data frames comprising a SONET/SDH layer into two or more logical channels." It has been shown above that Chen does not teach or suggest at least these features. Bisson has not been, and indeed cannot be, relied upon to cure at least this deficiency of Chen. Therefore, independent claim 8 is distinguishable over Chen and Bisson.

For at least due to its dependency from claim 8, claim 15 is also distinguishable over Chen and Bisson.

Applicant respectfully request that the rejection of claim 15 based on Chen and Bisson be withdrawn.

§ 103 REJECTION - CHEN

Claim 16 and 17 stand rejected under 35 U.S.C. §103(a) over Chen. Applicant respectfully traverses.

Claims 16 and 17 depend from independent claims 1 and 8 and it has been shown that the independent claims are distinguishable over Chen. For at least due to their dependency from the independent claims, claims 16 and 17 are also distinguishable over Chen.

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Applicant respectfully request that the rejection of claims 16 and 17 based on Chen be withdrawn.

**CONCLUSION**

All objections and rejections raised in the Final Office Action having been addressed, it is respectfully submitted that the present application is in condition for allowance. Should there be any outstanding matters that need to be resolved, the Examiner is respectfully requested to contact Hyung Sohn (Reg. No. 44,346), to conduct an interview in an effort to expedite prosecution in connection with the present application.

Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicant respectfully petitions for a one (1) month extension of time for filing a reply in connection with the present application, and the required fee of is attached hereto.

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If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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**4450-249P**

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